REMARKS

Claims 1-3 and 21-23 remain in the case, of which claims 15, 24-28 have been withdrawn from consideration.

Reconsideration in view of the following remarks and entry of the foregoing amendments are respectfully requested.

APPLICATION SERIAL NUMBER

As recommended by the Examiner, the Application Serial Number was inserted on every page of claims and of amendment of the present response.

REJECTIONS UNDER 35 U.S.C. § 112 SECOND PARAGRAPH

The Examiner has rejected claim 3 under 35 U.S.C. § 112, second paragraph as being indefinite for lacking punctuation.

It is unclear to the Applicant how claim 3 is lacking punctuation as it contains a period. Clarification is respectfully requested.

In view of the above and foregoing, it is respectfully requested that the Examiner withdraw his rejection of claim 3 under 35 U.S.C. § 112, second paragraph.

REJECTIONS UNDER 35 U.S.C. § 112, FIRST PARAGRAPH

Claims 1-3 and 21-23 have been rejected under 35 U.S.C. § 112, first paragraph as being indefinite. The Applicants respectfully traverse the rejection as follows.

The Examiner is of opinion that the claims contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. It is allegedly not clear whether the written description is sufficiently repeatable to avoid the need for a deposit or whether the starting materials were readily available to the public at the time of the invention.

While the Examiner recognizes that a deposit was made in the application as filed, it is not clear in his opinion that the deposit meets all the criteria set forth in 37 CFR

1.801–1.809. She thus suggests that a Declaration by the Applicant be made to overcome the lack of availability of biological material.

A Declaration containing the requested information is enclosed for the Examiner's review.

Additionally and as requested by the Examiner, the body of the specification (paragraph [0010]) was amended to include the date of deposit, the address of the depository and the complete taxonomic description.

In view of the above and foregoing, it is respectfully requested that the Examiner withdraw his rejection of claims 1-3, 21-23 under 35 U.S.C. § 112, first paragraph.

REJECTION UNDER 35 U.S.C. § 102 (B)

Claims 1-2, 21 and 22 have been rejected as being anticipated by Beauséjour *et al.* ("Beauséjour ") in light of Agbessi *et al.* ("Agbessi") under 35 U.S.C. § 102(b).

The Examiner alleges that since the Beauséjour published 2001 mentions the existence of EF-76 and that Agbessi published 12 March 2003 confirms that EF-76 is the same as BAA-668, that Beauséjour anticipates claims 1-2, 21 and 22 which claim strain BAA-668 or variants thereof.

Applicants respectfully traverse the rejection as follows.

A prior publication must be « enabling » if it is to be treated as prior art. *Azko N.V.* v. *U.S. Intern. Trade Com'n*, 5 Fed. Cir. (T) 52, 16731 USPQ2d (BNA) 1241 (1986).

In *In re LeGrice* (Application of LeGrice, 49 C.C.P.A. 1124, 133 USPQ (BNA) 365 (1962) which was specifically applied in a number of biological deposit cases, the court concluded that a mere description of a "rose floribunda plant" would not enable a person skilled in the art to reproduce the plant, since plant breeders "are not presently able to control the factors which govern the combination of genes and chromosomes required to produce a new plant having certain predetermined properties". Judge Smith also pointed out that "[s]hould a plant variety become extinct one cannot deliberately produce a duplicate even though its ancestry and the techniques of cross-pollination be known". Thus this prior publication did not meet the legal requirements for the bar stated in 35 U.S.C. § 102(b) as it did not communicate how the claimed material could be obtained.

The *LeGrice* holding was specifically applied to a utility patent application in *Ex parte Argoudelis*.[5] The Examiner had cited a Japanese reference which disclosed that an antibiotic with properties identical to applicants' sparsogenin A had been obtained in Japan from the fermentation broth of a strain of actinomyces isolated from the soil of Chiba prefecture, Japan, and described the cultivation of this strain. Argoudelis relied on the *LeGrice* decision. The Board declared:

> It cannot be denied that In re LeGrice applies to the publication cited in this application to the same extend that it applied to the publications cited in that case. Moreover, we have ourselves held that a written description of the character involved in a case such as the present one is not sufficient to enable a person skilled in the art to produce the invention.

This case recognized that an invention which is dependent on the availability of a specific bacterial strain for its practice is not anticipated by any prior art that does not make the strain itself available at the relevant time.

In re LeGrice, and *Ex parte Argoudelis* apply in the present case. The *Streptomyces melanosporofasciens* strain deposited as BAA-668 was not available to the public from ATCC or otherwise more than one year prior to the filing of the present application.

Beauséjour does not therefore meet the legal requirements for the bar stated in 35 U.S.C. § 102(b).

REJECTION UNDER 35 U.S.C. § 102 (A)

Claims 1-2, 21 and 22 have been rejected as being anticipated by Agbessi under 35 U.S.C. § 102(a) since these claims are directed to strain BAA-668 or variants thereof.

Applicants respectfully traverse the rejection as follows.

Agbessi is describing the inventors own work published less than one year before the filing of the present application. The enclosed Declaration confirms that all named inventors to the present application are coauthors to Agbessi, and that Claude Déry, the remaining coauthor of Agbessi, does not qualify as an inventor. Applicant submits that

such Declaration is sufficient to remove the publication Agbessi as a reference under 35 U.S.C. 102(a) *In re Katz*, 687 F.2d 450, 215 USPQ 14 (CCPA 1982).

REJECTION UNDER 35 U.S.C. § 103

Claims 1-3 and 21-23 have been rejected as being obvious over Beauséjour over Agbessi and Suh under 35 U.S.C. § 103(a). The Examiner is of opinion that the claims are obvious because the references allegedly differ from the claimed invention only in that an inoculum comprising chitosan is not disclosed, and that chitosan is known in the art in the context of pesticidal compositions of *Streptomyces*.

Applicants respectfully traverse the rejection as follows.

As indicated above, Beauséjour does not disclose the claimed strain because it did not enable a person skilled in the art to reproduce this strain and does not meet therefore legal requirements for constituting relevant prior art.

As indicated above, Agbessi is not citable as prior art as it describes the inventors' own work published less than one year prior to the present application and does not meet therefore legal requirements for constituting relevant prior art.

Suh does not disclose or make obvious the claimed strain or its variant and does not cure the deficiencies of other art cited herein.

The rejections of the original claims are believed to have been overcome by the present remarks and the introduction of new claims. From the foregoing, further and favorable action in the form of a Notice of Allowance is believed to be next in order, and such an action is earnestly solicited.

PETITION FOR THREE-MONTH EXTENSION OF TIME

Applicants hereby request that the period for responding to the Office Action dated October 18, 2006, and originally set to expire January 18, 2007, be extended by three (3) months, so as to expire on April 18, 2007.

The Commissioner is authorized to charge the amount of $510, to cover the one-month extension herein requested, to Deposit Account No. 07-1742. The

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Commissioner is further authorized to charge any deficiencies or to credit any overcharges to this same Deposit Account number.

Favorable action on this request for extension of time is courteously solicited.

Authorization is hereby given to charge Deposit Account no. 07-1742 for any deficiencies or overages in connection with this response.

Respectfully submitted,

Beaulieu et al.

by: GOUDREAU GAGE DUBUC

Julie Gauvreau
Reg. No. 52,532

Date: 17 April, 2007

(514) 397-4374
Encls.: Declaration under 1.132 –In re Katz
Declaration under 1.132